



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kaoru TORIKOSHI

Group Art Unit: 1774

Application No.: 09/998,340

Examiner: B. Shewaraged

Filed: December 3, 2001

Docket No.: 111243

For: IMAGE RECORDING MATERIAL AND METHOD FOR PRODUCING THE SAME

PETITION FOR REFUND

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is respectfully requested that the fees paid for the Petition for Three-Month Extension of Time and Notice of Appeal submitted in reply to the February 11, 2004, Final Rejection be refunded.

On February 11, 2004, a Final Rejection was mailed for the above-identified application. Applicant timely filed a Request for Reconsideration on May 11, 2004. *See* the attached date-stamped receipt.

Since the original filing of the Request for Reconsideration on May 11, 2004, Applicant's undersigned representative has taken the following numerous steps to obtain prompt entry and examination of the Request for Reconsideration.

- on May 26, Applicant's representative left a voicemail message for Ex. Shewaraged requesting information regarding the status of the May 11 Request for Reconsideration;

- on May 27, Ex. Shewaraged left a voicemail message for Applicant's representative requesting a return call;

- on May 27, Applicant's representative called Ex. Shewaraged who stated that she did not have the file or the Request for Reconsideration yet and to call her back in one week;

- on June 8, Applicant's representative called Ex. Shewaraged who stated that she did not have the file or the Request for Reconsideration and nothing has been scanned for her to review. She could not give any indication of when she would have access to the file and its contents;

- on June 8, Applicant's representative left a voicemail message for SPE Harris-Kelly requesting information regarding the status of the file and Request for Reconsideration since the PAIR system, which Applicant's representative checked that same day, indicated that SPE Harris-Kelly has had the file since May 6;

- on June 21, Applicant's representative checked the PAIR system to find no change in either application status or file location;

- on June 28, Applicant's representative checked the PAIR system to find no change in either application status or file location;

- on July 9, Applicant's representative checked the PAIR system to find no change in either application status or file location;

- on July 12, Applicant's representative checked the PAIR system to find no change in either application status or file location;

- on July 12, Applicant's representative left voicemail messages for Ex. Shewaraged and SPE Harris-Kelly requesting information regarding the status of the May 11 Request for Reconsideration;

- on July 12, SPE Harris-Kelly left Applicant's representative a voicemail message stating she was no longer Ex. Shewaraged's supervisor. However, she had talked to Ex. Shewaraged who was supposed to have moved this application and have contacted Applicant's representative. SPE Harris-Kelly stated that prosecution may be re-opened;

- on July 12, Applicant's representative left a voicemail message for Ex. Shewaraged regarding the information provided by SPE Harris-Kelly;

- on July 12, Ex. Shewaraged called Applicant's representative stating that the Request for Reconsideration had not been scanned and is unavailable, but that a courtesy copy could be faxed to her along with a copy of the date-stamped receipt;

- on July 12, Applicant's representative faxed Ex. Shewaraged a copy of the Request for Reconsideration and date-stamped receipt (copy of the facsimile enclosed);

- on July 13, Ex. Shewaraged called Applicant's representative stating that she did not think the claims were allowable and would consider sending an Advisory Action;

- on August 2, Applicant's representative checked the PAIR system and found that the May 11 Request for Reconsideration was no longer listed on the File History Contents page, but that the courtesy copy of July 12 had been entered as "untimely";

- on August 2, Applicant's representative left Ex. Shewaraged a voicemail message requesting information regarding the Advisory Action, which had not been received, and requesting information regarding the status of the Request for Reconsideration in view of the erroneous PAIR system deletion and entry;

- on August 2, Ex. Shewaraged left Applicant's representative a voicemail message stating that the courtesy copy of the Request for Reconsideration faxed to her on July 12 had been entered as untimely because it was not signed. Ex. Shewaraged stated that she understands that the July 12 facsimile was a courtesy copy and that the May 11 Request for

Reconsideration was signed and timely filed. She further stated that Applicant's representative could call Examiner Shewaraged's supervisor, Rena Dye, but SPE Dye is not available until next week due to training;

- on August 2, Applicant's representative called SPE Dye's phone number (provided by Ex. Shewaraged), but the voicemail was not set up for SPE Dye, and thus Applicant's representative did not leave a message;

- on August 2, Applicant's representative called the general information phone number for Art Unit 1774 to determine the name of the acting supervisor while SPE Dye was in training. The general information system connected Applicant's representative to SPE Harris-Kelly. Applicant's representative left SPE Harris-Kelly a voicemail message explaining what had happened thus far and requesting a return phone call from her or the appropriate acting supervisor;

- on August 4, Applicant's representative left a voicemail message for TC 1700 Director Stone explaining that the statutory bar date of August 11 was approaching and that guidance was needed regarding how to proceed in view of the erroneous entry in the PAIR system;

- on August 9, Applicant's representative checked the PAIR system to find the May 11 Request for Reconsideration and the July 12 courtesy copy both entered appropriately and scanned (along with all other file documents); and

- on August 11, Applicant's representative filed a Notice of Appeal and Petition for a three-month extension of time along with this Petition for Refund.

Accordingly, despite Applicant's repeated attempts to obtain any official communication from the Patent Office in response to the Request for Reconsideration, no action has been taken by the Patent Office and no Advisory Action has been issued.

Applicant timely submitted the Request for Reconsideration prior to expiration of the three month shortened statutory period, and no action has been taken by the Patent Office during the entire three month extension of that shortened statutory period. Applicant was thus forced to file a Notice of Appeal and Petition for Extension of Time, at a cost of \$950.00 in extension fees and \$330.00 in Notice of Appeal fees (for a total cost of \$1,280.00), in order to maintain the pendency of the application. Applicant incurred all of these expenses solely because of Patent Office delay.

Accordingly, it is respectfully requested that \$1,280 be refunded to Deposit Account No. 15-0461 and that the Patent Office acknowledge this credit in writing.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Kristin K. Vidovich
Registration No. 41,448

JAO/KKV:amw

Attachments:

Request for Reconsideration filed May 11, 2004 w/Stamped Receipt
Courtesy Copy of Request for Reconsideration w/Facsimile Transmission Receipt

Date: August 11, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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PTO RECEIPT FOR FILING OF PAPERS



► **Mail Room (Regular Delivery)**

The following papers have been filed:

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION UNDER 37 C.F.R.
§1.116

Name of Applicant: Kaoru TORIKOSHI

Serial No.: 09/998,340

Atty. File No.: 111243

Title (New Cases): IMAGE RECORDING MATERIAL AND METHOD FOR
PRODUCING THE SAME

Sender's Initials: JAO/KKV:amw

PATENT OFFICE DATE STAMP



272/24

**COPY TO BE STAMPED BY PATENT OFFICE
AND RETURNED BY MESSENGER**

**Oloff & Berridge, PLC
277 S. Washington Street, Suite 500, Alexandria, Virginia 22314**